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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,637

Applicant(s)

LEBOK ET AL.

Examiner

LORI MATTISON

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/04/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36, 38-62, 64-75 and 77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36, 38-62, 64-75 and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 36, 38-62, 64-75 and 77 are pending.
2. Applicant's amendment to claim 36 as well as submission of new claim 77 filed on 5/04/2009 is acknowledged.

Claims 36, 38-62, 64-75 and 77 are pending and examined on the merits.

3. The text of those sections of Title 25 U.S. Code not included in this action can be found in a prior Office action.
4. The objections and rejection not recited in this action are withdrawn.

Claim Objections

Claim 40 remains objected to because of the following informalities: the scientific names are not properly formatted, e.g. *Rhus succedanea*.

Applicant may obviate this rejection by italicizing the name *Rhus succedanea* in instant claim 40.

Claim Rejections - 35 USC § 112

Claims 36, 38-62, and 64-75, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The base claim, claim 37 has been cancelled. M.P.E.P. § 608.01 (n) explicitly directs, "If the base claim has been canceled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete."

Applicant should consider whether amending instant claims 38-46 to depend from instant claim 36 would to obviate the rejection.

Instant claim 36 is indefinite because the metes and bounds of the claim are unclear. In particular, it is unclear as to what a single oil phase would be as opposed to multiple oil phases. One of ordinary skill in the art would not be able to identify whether a composition which comprises mixtures of oils would be recognized as comprising a single oil phase or multiple oil phases (i.e. one oil= one phase). Furthermore, it is unclear as to how a mixture of a solid wax and an oil (i.e. a liquid) may comprise a single oil phase as the weight of the wax particles may cause settling out from the oil to potentially create two phases.

Because claims 38-62, 64-75, and 77 depend from instant claim 36, they must also be rejected under 35 USC 112, second paragraph

Claim Rejections - 35 USC § 103

Invention Summary: The instant invention is focused on using cosmetic reagents that are renewable (i.e. originating from plant based materials). The instant application works to overcome the problem of rancidity, which is associated with use of vegetable-based raw materials in cosmetics. To reduce rancidity, and promote smooth application, applicant teaches use of a mixture of meadowfoam seed oil and hydrogenated jojoba oil.

Note: In order to promote a more compact prosecution, instant claims 38 to 46, which depend from cancelled claim 37, have been interpreted as being dependent from instant claim 36.

Claims 36, 43, 46-50 remain rejected and claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,086,859 (Calello, 2000) in view of newly applied *Toxic Chemicals in Cosmetics* accessed from www.hallgold.com/toxic-chemical-ingredients-directory.htm, newly applied *Chemistry in Cosmetics*, ncwsnc.cheminst.ca/articles/2001_cosmetics_e.htm, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*. www.jonentine.com/articles/drug_cosmetic_ind.htm, published 2/01/1995, US Patent No. 5683972 (Zocchi, 1997), Minorsky as published in *Plant Physiology* in 2000, and Beauty Care.com, www.beautycare.com/cgi-bin/trends/viewnews.cgi?newsid945548222,2469, archived February 2000, accessed 1/27/2009. The newly applied references were applied in response to applicant's amendment of the claims submitted 05/04/2009.

Additionally, to promote a more compact prosecution, an oil phase has been interpreted to mean any vegetable oils, vegetable waxes, and mixtures of oils and waxes.

Calello discloses lipid bearing preparations for cosmetic use (lipstick; column 1, lines 62-65), comprising an oil phase, and a solid phase (pigment; column 2, lines 45-58), wherein the oil phase comprises a mixture of vegetable-base raw materials which

are selected from materials, such as vegetable oils, hydrogenated vegetable oils, vegetable waxes and mixtures thereof (column 3, lines 50-51). Calello provides a suggestion to optimize the composition by teaching that the skin protectant may be natural substances such as coco butter and synthetic substances such as petrolatum and dimethicone (column 2, lines 1-15). The composition may comprise an oil selected from nonvolatile oils, volatile oils, and mixtures thereof (column 1, lines 40-60). Nonvolatile oils from vegetable sources are taught such as corn oil, cottonseed oil, olive oil, palm oil, linseed oil, walnut oil, sunflower seed oil, soybean oil, rapeseed oil, and the like (column 3, lines 45-60). Nonvolatile oils may also be derived from synthetic sources (i.e. mineral oil; column 3, lines 50-end). Calello's composition also comprises a wax (column 1, lines 40-60), which may be derived from a plant (i.e. vegetable), mineral, or synthetic sources (column 4, lines 60-end; column 5, lines 1-15). Calello invites optimization through routine experimentation by teaching that the preferred embodiment does not limit the scope of the invention to a particular form and that his invention is meant to cover alternatives, modifications, and equivalents which are within the spirit and scope of invention (column 9, lines 45-end; column 10, lines 1-10).

Calello's pigmented lipstick composition comprises 1-25% pigment (i.e. solid phase), 0.01-30% skin protectant, 5-80% of a selected from volatile and nonvolatile oils (i.e. an oil phase; instant claim 43) and 3-40% of a wax (i.e. an oil phase; instant claims 43 and 46). Calello teaches that the oil may be naturally occurring and derived from a vegetable source. Castor oil is specifically taught as a suitable oil (Col. 3, lines 45-60). Calello specifically teaches that hydrogenated jojoba oil may be used as the wax in the

composition (Col.4, lines 55-end; instant claims 43 and 47). Calello hints about the importance of meadowfoam seed oil for use in his composition by teaching a carboxylic acid wherein the substituent is selected to provide an ingredient known as meadowfoam seed oil (Col. 4, lines 25-45; instant 47).

Calello does not embody a composition which comprises a single oil phase which consists of a mixture of vegetable based raw material selected from the group consisting of vegetable oils, hydrogenated vegetable oils, vegetable waxes and mixtures thereof as set forth by instant claim 36.

Calello does not teach inclusion of meadowfoam seed oil as set forth by instant claim 38.

Calello does not teach that the amounts of hydrogenated jojoba oil and meadowfoam seed oil are each in the range of between 2 and 35% by weight with respect to the total weight of the preparation as set forth by instant claim 48.

Calello does not teach that the amounts of hydrogenated jojoba oil and meadowfoam seed oil are each in the range of between 5 and 25% by weight with respect to the total weight of the preparation as set forth by instant claim 49.

Calello does not teach that cosmetic composition wherein the ratio of the amounts of hydrogenated jojoba oil to meadowfoam seed oil is between 1:2 and 2:1 as set forth by instant claim 50.

Minorsky teaches that meadowfoam seed oil comprises a high percentage of eicosenoic acid that is more stable to oxidation, a property that makes it especially desirable for use in cosmetics (page 1, Column 3, last paragraph).

Zocchi teaches that meadowfoam seed oil and castor oil are equivalents that are responsible for providing skin conditioning and feel to compositions (Col. 2, lines 45-65).

Beautycare.com teaches that it is the amount of wax in a lipstick that helps it glide on to the lips. The wax may also help to moisturize dry lips (paragraph 3, page 1).

Toxic Chemicals in Cosmetics teaches that cyclomethicone to be among the silicone emollients that cause skin irritation and potentially act as tumor promoters (page 9, silicone derived emollients).

Chemistry in Cosmetics teaches that there was a rising demand from consumers for natural, plant based products with no synthetic chemicals (page 1, paragraph 5).

Green Cosmetics teaches that there is an active movement, especially in the cosmetics industry, to market green products (page 1, last paragraph). Green marketing has evolved into something approximating a religion (page 1, last paragraph). The green philosophy covers a range of ingredients and formulations (page 1, last paragraph). The green philosophy has been used in the cosmetics field for decades to market cosmetics (page 2, paragraph 2). *Green Cosmetics* goes on to teach that in the cosmetics field, having no animal byproducts in the formulations is boast-worthy (page 4, paragraph 2).

With regard to instant claim 36 and 77, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have removed the nonvegetable oils and waxes, such as cyclomethicone from the composition taught by Calello to form a single oil phase that consists of a mixture of vegetable based raw material selected from the group consisting of vegetable oils, hydrogenated vegetable

oils, vegetable waxes and mixtures because silicones such as cyclomethicone, which are not vegetable based are taught to be an undesirable reagent for cosmetics because it causes skin irritation and may potentially be a tumor promoter as taught by *Toxic Chemicals in Cosmetics*.

With regard to instant claims 36 and 77, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have replaced the synthetic oils, synthetic wax derivatives, animal oil and animal derived waxes taught by Calello with the natural plant based alternatives taught by Calello because *Chemistry in Cosmetics* teaches that there was a rising demand from consumers for natural, plant based products with no synthetic chemicals, while *Green Cosmetics* teaches that formulations which do not contain animal byproducts are boast-worthy in the cosmetics field.

With regard to instant claims 38, a person of ordinary skill in the art would have had a reasonable expectation of success in substituting meadowfoam seed oil for castor oil in the composition taught by Calello because meadowfoam seed oil is an equivalent for castor oil as taught by Zocchi. The skilled artisan would have been motivated to do so because meadowfoam seed oil is more stable to oxidation as taught by Minorsky.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to have substituted meadowfoam seed oil for castor oil in the composition of Calello because meadowfoam seed oil is an oxidation stable equivalent of castor oil as taught by Minorsky and Zocchi.

With regard to the weight percentages of meadowfoam seed oil and hydrogenated jojoba oil in recited instant claims 48 and 49, the selection of 2-35% and 5-25% weight percent of hydrogenated jojoba oil and meadowfoam seed oil would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that meadowfoam seed oil is an oil and oils are taught by Calello to comprise from 5-80% of the composition, while waxes, such as hydrogenated jojoba oil, are taught by Calello to comprise 3-40% of the composition, said artisan recognizing that optimizing the amount of meadowfoam seed oil impacts the conditioning properties of the composition as taught by Zocchi and optimizing the amount of wax impacts the moisturizing and application properties of the composition as taught by Beautycare.com. A holding of obviousness over the cited claims is therefore clearly required.

With regard to the ratio of hydrogenated jojoba oil and meadowfoam seed oil (instant claim 50), the selection of 1:2 to 2:1 ratio of hydrogenated jojoba oil to meadowfoam seed oil would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that meadowfoam seed oil is an oil which may comprise from 5-80% of the composition and hydrogenated jojoba oil a wax which may comprise 3-40% of the composition as taught by Calello, said artisan recognizing that optimizing the ratio of meadowfoam seed oil to the hydrogenated jojoba oil optimizes the conditioning and application properties of the composition as taught by Beautycare.com. A holding of obviousness over the cited claims is therefore clearly required.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claim 66 has only changed with regard to the amendments made to the independent claim 36 from which claim 66 depends. The amendments to claim 36 have been discussed above

Claims 36, 39 and 73 are rejected and claims 68, 74 and 75 remain rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,277,182 (Lebok, 2001) in view of newly applied *Chemistry in Cosmetics*, ncwsnc.cheminst.ca/articles/2001_cosmetics_e.htm and in further view of US Patent No. 6,019,962 (Rabe, 2000). The newly applied references were applied in response to applicant's amendment of the claims submitted 05/04/2009.

Example III of Lebok teaches a lipliner (i.e. a lip care pencil; Col. 6, lines 1-25; instant claim 36). The lipliner comprises a vegetable oil phase of castor oil and hydrogenated vegetable oil (Col. 6, lines 1-25; instant claims 36 and 39). A solid phase is also present (Col. 6, lines 1-25; instant claim 36). The composition comprises pigment (Col. 6, lines 1-25). The composition also comprises C₃₀₋₄₅ alkylmethicone which is taught to be important for the structure of the gel (Col. 6, lines 1-25; column 2, lines 55-end; Col. 6, lines 1-25). Lebok teaches that the C₃₀₋₄₅ alkylmethicone (i.e. a synthetic chemical) can not be substituted with a natural wax, such as candelilla wax, because the natural wax can not keep the oil components in a stable structure (column 2, lines 55-end).

Example III of Lebok teaches a lipliner (Col. 6, lines 1-25). The lip liner material of Example 3 was cast into molds and cooked to produce shaped leads (i.e. stick; instant claims 73 and 75). These leads were placed into the sleeve banks, glued, and further processed to produce a pencil (instant claims 68, 73 and 75). Lebok teaches that these sleeves may be wood or plastic (Col. 4, lines 30-40; instant claims 73 and 75), thus they are equivalents. In a separate embodiment, Lebok teaches that casting in molds that are mounted on rotary mechanisms, hence the preparation is directly cast into the rotary mechanism to form a pencil (Col.4, lines 60-end) (reading on instant claims 74).

Lebok does not exemplify casting the leads (i.e. stick) into wood as set forth by instant claim 75.

Lebok does not teach use of hydrogenated vegetable oils as the solid former for the composition.

Chemistry in Cosmetics teaches that there is a rising demand from consumers for natural, plant based products with no synthetic chemicals (page 1, paragraph 5).

Rabe teaches compositions and methods for improving cosmetic products (title). Rabe's cosmetic formulations comprises solid formers which may be selected from the group comprising waxes and solid oils (column 5, lines 15-30; column 8, lines 60-end; column 9, lines 1-10; column 8, lines 25-40). Rabe goes on to teach that C₂₄₋₄₅ alkyl methicone is a suitable wax solid former for the invention (column 8, lines 25-35). Rabe further teaches that hydrogenated vegetable oil is a suitable solid oil (i.e. solid former)

for the composition (column 8, lines 40-55). Thus, Rabe teaches that C₂₄₋₄₅ alkyl methicone and hydrogenated vegetable oils are functionally equivalent solid formers.

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have substituted hydrogenated vegetable oil for the C₃₀₋₄₅ alkylmethicone in Lebok's composition because hydrogenated vegetable oil and C₃₀₋₄₅ alkylmethicone are functional equivalents, i.e. solid formers, used in cosmetic formulations as taught by Rabe. The artisan of ordinary skill would have been motivated to do so in order to meet consumer demand for natural, plant based cosmetic products which have no synthetic chemicals as taught by *Chemistry in Cosmetics*.

With regard to instant claim 73, a person of ordinary skill in the art would have had a reasonable expectation of success in modifying the composition taught by Lebok so that such that the composition comprises a stick (a lead) in wood because Lebok teaches a composition which comprises a stick (or lead) glued into sleeve banks which may be either wood or plastic. The skilled artisan would have been motivated to so because Lebok extends an invitation to optimize the composition by selecting either wood or plastic.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to select a sleeve of wood in which the lead could be placed and glued because Lobok teaches sleeve may be made of wood.

With regard to instant claim 75, With regard to the method, a person of ordinary skill in the art would have had a reasonable expectation of success in casting the preparation into wood sleeves, gluing it and further processing it because Lebok

teaches placing leads into the sleeve banks, which may be either wood or plastic, gluing them and further processing them to produce a pencil. The skilled artisan would have been motivated to do so because Lebok teaches that sleeve may be made out of either wood or plastic and extends the invitation to optimize.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method taught by Lobek to involve placing the lead (i.e. casting the lead) into the wooden sleeves because Lobek teaches that lead may be cast into either wood or plastic.

With regard to the method of casting the preparation into a rotary mechanism of a pencil to form a lead, a person of ordinary skill in the art would have had a reasonable expectation of success in casting preparation of Lebok into molds that are mounted on rotary mechanisms to form a lead pencil because Lebok teaches a method in which a preparation is directly cast into the rotary mechanism to form a pencil. The skilled artisan would have been motivated to do so because Lebok extends an invitation to optimize the process by teaching that the preparation may be placed in sleeves and glued, or may be casting the preparation into directly into sleeves that have been placed into rotary mechanisms.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to have cast the preparation into sleeves that have been place into a rotary mechanism to form a lead.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claims 36, 41, 42, 44, 45, 51, 53, 54, 64, and 65 remain rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,355,261 (Bonda, 2002) in view of each newly applied *Chemistry in Cosmetics*, ncwsnc.cheminst.ca/articles/2001_cosmetics_e.htm, newly applied *Toxic Chemicals in Cosmetics* accessed from www.hallgold.com/toxic-chemical-ingredients-directory.htm, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, www.jonentine.com/articles/drug_cosmetic_ind.htm, published 2/01/1995. The newly applied references were applied in response to applicant's amendment of the claims submitted 05/04/2009.

Example III of Bonda (Col. 16, lines 25-end) teaches a lipstick composition which comprises an oil phase which contains castor oil present in an amount of 41% (Col. 16, lines 25- end; instant claims 36, 41, 44). Vegetable waxes (Candellila and carnauba) are also present as an oil phase, comprising 7% of the composition by weight (Col. 16, lines 25- end; instant claims 36, 42, and 45). The composition comprises a solid phase which contains pigments and a barium lake (Col. 16, lines 25- end; instant claims 36, 51 and 54). The combined amount of the pigments are 3.0% of the composition (Col. 16, lines 25- end). The composition also comprises mica (Col. 16, lines 25- end; instant claims 51 and 53). Bonda exemplifies used of methyl and propyl parabans the lipstick of Example III (Col. 16, lines 25-end). Bonda teaches that rosemary extract, methyl paraben, and propyl paraben are equivalent preservative agents. (Col. 12, lines 1-5; instant claim 64). Bonda further teaches use of preservatives in an amount of 0.5% by weight (Classic lipstick, Col. 11, lines 25-40; instant claim 65). In the classic lipstick

formulation, Bonda teaches use of organically modified silicones and lanolin (i.e. animal by-product) among other natural emollients which may be used in the lipstick composition (column 11, lines 35-50). Bonda's classic lipstick may also comprise animal-derived or synthetic waxes such as alkyl silicones, synthetic waxes and lanolin, along with natural vegetable waxes such as carnauba or candelilla (column 11, lines 40-55).

Bonda does not embody an oil phase consisting of only vegetable based products as set forth by instant claim 36.

Chemistry in Cosmetics teaches that there is a rising demand from consumers for natural, plant based products with no synthetic chemicals (page 1, paragraph 5).

Toxic Chemicals in Cosmetics teaches that some silicone emollients cause skin irritation and potentially act as tumor promoters (page 9, silicone derived emollients).

Green Cosmetics teaches that there is an active movement, especially in the cosmetics industry, to market green products (page 1, last paragraph). The green marketing has evolved into something approximating a religion (page 1, last paragraph). The green philosophy covers a range of ingredients and formulations (page 1, last paragraph). The green philosophy used in the cosmetics field for decades (page 2, paragraph 2). *Green Cosmetics* goes on to teach that in the green cosmetics field, having no animal byproducts in the formulations is boast worthy (page 4, paragraph 2).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have removed the synthetic and animal-derived reagents from Bonda's composition and substituted the plant based reagents taught by

Bonda to produce an oil phase consisting of vegetable based raw product in order to meet consumer demand for cosmetics with no synthetic chemicals. The artisan of ordinary skill would have been further motivated to remove the animal reagents and substitute natural plant based reagents in Bonda's composition to meet the consumer demand for a green cosmetics, with said artisan recognizing that cosmetic compositions which comprise no animal byproducts are boast worthy.

Claim 66 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bonda, newly applied *Chemistry in Cosmetics*, *Toxic Chemicals in Cosmetics*, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High* as applied to claims 36, 41, 42, 44, 45, 51, 53, 54, 64, and 65 above, and further in view of US Patent No. 6,641,845 (Kogyo, 2003).

Applicant's amendment to instant claim 36 required the newly applied references to provide a motivation to remove the non-vegetable based reagents from the oil phase and/or substitute vegetable-based equivalents for the non-vegetable based reagents to the oil phase. The teachings of the newly applied references are discussed above in the obviousness rejection of the independent claim. Claim 66 has only changed with regard to the amendments made to the independent claim 36 from which claim 66 depends. The amendments to claim 36 have been discussed above.

Claim 67 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bonda, newly applied *Chemistry in Cosmetics*, newly applied *Toxic Chemicals in Cosmetics*, and newly applied *Green Cosmetics: The Definition Undergoes Broadening*

but Consumer Interest Remains High as applied to claims 36, 41, 42, 44, 45, 51, 53, 54, 64, and 65 above and further in view of US Patent No. 2,873,229 (Wick, 1959) and US Patent No. 2,708,631 (Neiman, 1955).

Applicant's amendment to instant claim 36 required the newly applied references to provide a motivation to remove the non-vegetable based reagents from the oil phase and/or substitute vegetable-based equivalents to the oil phase. The teachings of the newly applied references are discussed above in the obviousness rejection of the independent claim. Claim 67 has only changed with regard to the amendments made to the independent claim 36 from which claim 66 depends. The amendments to claim 36 have been discussed above..

Claims 36 and 69 are rejected and claim 73 remains rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application GB 2084084 (Morane, 1981), in view of each newly applied *Chemistry in Cosmetics*, ncwsnc.cheminst.ca/articles/2001_cosmetics_e.htm, newly applied *Toxic Chemicals in Cosmetics* accessed from www.hallgold.com/toxic-chemical-ingredients-directory.htm, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, www.jonentine.com/articles/drug_cosmetic_ind.htm, published 2/01/1995. The newly applied references were applied in response to applicant's amendment of the claims submitted 05/04/2009.

Example III (page 4, lines 25-55) of Morane teaches a composition against rings under the eyes (i.e. a makeup). This composition comprises a vegetable oil phase

comprising carnauba wax and a solid phase comprising iron oxide (page 4, lines 25-55; instant claim 36). The composition is disclosed as being cased into a pencil corresponding to the Figure I which is the first embodiment. This first form is a sheath made of plastic (page 1, lines 30-45; instant claim 69). Morane teaches that the composition is cast right into the sleeve (page 1, lines 50-60; instant claim 69).

Morane's composition does not exemplify an oil phase consisting of vegetable based materials which is free of synthetic chemicals and animal byproducts as set forth by instant claim 36.

Chemistry in Cosmetics teaches that there is a rising demand from consumers for natural, plant based products with no synthetic chemicals (page 1, paragraph 5).

Toxic Chemicals in Cosmetics teaches that some silicone emollients cause skin irritation and potentially act as tumor promoters (page 9, silicone derived emollients).

Green Cosmetics teaches that there is an active movement, especially in the cosmetics industry, to market green products (page 1, last paragraph). The green marketing has evolved into something approximating a religion (page 1, last paragraph). The green philosophy covers a range of ingredients and formulations (page 1, last paragraph). The green philosophy used in the cosmetics field for decades (page 2, paragraph 2). *Green Cosmetics* goes on to teach that in the green cosmetics field, having no animal byproducts in the formulations is boast worthy (page 4, paragraph 2).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have removed the synthetic and animal-derived reagents from Morane's composition and substituted plant based equivalents to

produce an oil phase consisting of vegetable based raw product in order to meet consumer demand for cosmetics with no synthetic chemicals. The artisan of ordinary skill would have been further motivated to remove the animal reagents and substitute natural plant based reagents in Morane's composition to meet the consumer demand for green cosmetics. The artisan of ordinary skill, at the time the invention was made, knew that that cosmetic compositions which comprised no animal byproducts were boast worthy products for cosmetics companies.

Claims 36, 38, 51-53, 56, and 57 remains rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,437,895 (Koulbanis, 1984) in view of each newly applied *Chemistry in Cosmetics*, ncwsnc.cheminst.ca/articles/2001_cosmetics_e.htm, newly applied *Toxic Chemicals in Cosmetics* accessed from www.hallgold.com/toxic-chemical-ingredients-directory.htm, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, www.jonentine.com/articles/drug_cosmetic_ind.htm, published 2/01/1995. The newly applied references were applied in response to applicant's amendment of the claims submitted 05/04/2009.

Example 10 of Koulbanis teaches a lipstick composition (Col. 5 lines 60-end; Col. 6 lines 1-5). The composition comprises a solid phase which comprises the organic and inorganic pigments of red iron oxide, yellow iron oxide, DC Red 7 (calcium salt), DC Yellow 6 (aluminum salt) and DC Red 36 in an amount of 1%, 1%, 2%, 2%, and 1.5% by weight respectively. Thus, the pigments comprise 7.5% of the composition (instant

56). The composition comprises the lipid phase of Example 7 (Col. 5 lines 20-40), which comprises an oil phase which is a mixture of jojoba oil and mango oil (instant claim 38). The lipstick composition comprises this oil mixture in an amount of 13.5% by weight.

Example 11 of Koulbanis discloses a rouge (i.e. makeup)(Col. 6 lines 5-30). The composition comprises a solid phase which comprises the organic and inorganic pigments of silicates with a high magnesium content, titanium dioxide, iron oxides, titanium mica, and DC Red 7 (calcium lake) in an amount of 2%,1%, 2%, 5%, and 0.3% by weight respectively (instant claims 51 and 53). Thus, the pigments comprise 10.3% of the composition (instant claims 56 and 57). The composition of Example 11 also comprises a mixture of vegetable oils (i.e. an oil phase) which contains mango oil and jojoba oil (instant claim 38). The oil phase of Example 11 comprises 20% of the composition. Koulbanis teaches that fillers such as talc and kaolin may also be included in the composition (Col.3, lines 45-55; instant claims 51 and 52).

Koulbanis teaches that his invention, and contribution to the cosmetics field, is a stable mixture of vegetable oils that are stable to oxidation (column 1, lines 45-60).

Koulbanis does not embody an oil phase consisting of vegetable based materials which is free of synthetic chemicals and animal byproducts as set forth by instant claim 36.

Chemistry in Cosmetics teaches that there is a rising demand from consumers for natural, plant based products with no synthetic chemicals (page 1, paragraph 5).

Toxic Chemicals in Cosmetics teaches that some silicone emollients cause skin irritation and potentially act as tumor promoters (page 9, silicone derived emollients).

Green Cosmetics teaches that there is an active movement, especially in the cosmetics industry, to market green products (page 1, last paragraph). The green marketing has evolved into something approximating a religion (page 1, last paragraph). The green philosophy covers a range of ingredients and formulations (page 1, last paragraph). The green philosophy used in the cosmetics field for decades (page 2, paragraph 2). *Green Cosmetics* goes on to teach that in the green cosmetics field, having no animal byproducts in the formulations is boast worthy (page 4, paragraph 2).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have removed the synthetic and animal-derived reagents from Koulbanis' composition and substituted plant based equivalents to produce an oil phase consisting of vegetable based raw products in order to meet consumer demand for cosmetics with no synthetic chemicals. The artisan of ordinary skill would have been further motivated to remove the animal reagents and substitute natural plant based reagents in Koulbanis' composition to meet the consumer demand for green cosmetics. The artisan of ordinary skill, at the time the invention was made, knew that that cosmetic compositions which comprised no animal byproducts were boast worthy products for cosmetics companies.

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koulbanis, newly applied *Chemistry in Cosmetics*, newly applied *Toxic Chemicals in*

Cosmetics, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, as applied to claims 36, 38, 51-53, 56, and 57 above and in further view of US Patent No. 2,131,046 (Hoffman, 1938) and Japanese Patent No. 406181813 (Okada, 1994)..

Claim 70 has only changed with regard to the amendments made to the independent claim 36 from which claims 70 depends. The amendments to claim 36 have been discussed above.

Claims 36, 40-42, 44, 45, 51, 54, 55, and 72 remain rejected and claim 77 is newly rejected under 35 U.S.C. 103(a) as being unpatentable over Papantoniou in view of each newly applied *Chemistry in Cosmetics*, ncwsnc.cheminst.ca/articles/2001_cosmetics_e.htm, newly applied *Toxic Chemicals in Cosmetics* accessed from www.hallgold.com/toxic-chemical-ingredients-directory.htm, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, www.jonentine.com/articles/drug_cosmetic_ind.htm, published 2/01/1995 and in further view of US Patent No. 2,190,844 (Mills, 1940). The newly applied references were applied in response to applicant's amendment of the claims submitted 05/04/2009.

The examiner notes that instant claim 72 includes product-by-process limitations. The discussion of product-by-process limitations in the above rejection of claim 70 over Koulbanis and Davis also applies to claim 72.

Once a product appearing to be substantially identical is found and an art rejection made, the burden shifts to the applicant to show an unobvious difference.

Example III (Col 10, lines 30-55) of Papantoniou discloses a lip polish (i.e. make up; instant claim 36). This lip polish comprises a lipid component (Fatty composition C). The lip composition does not comprise mineral oils. Fatty composition C comprises the vegetable oil phases of candellila wax, carnauba wax, and ricin oil (Col 10, lines 30-55; instant claims 36 and 40); these reagents comprise 1.9%, 1.9%, and 37% by weight, of the composition respectively. Thus the content of the vegetable oils is 37% (Col 10, lines 30-55; reading on instant claims 41, 44) and the content of the vegetable waxes is 3.8% (Col. 10, lines 30-55; instant claims 42 and 45). The composition comprises a solid phase which comprises the aluminum lake of the organic pigment FD&C Yellow No.5. and Zirconium lake of the organic pigment D and C red No 21 (column 10, lines 30-45; instant claims 51, 54, and 55). The solid phase comprises 2% of the composition by weight. Papantoniou teaches that the lip polish is in a form of a paste (Col. 6 lines 21-25). Papantoniou teaches vegetable based waxes such as carnauba wax and coco butter for use in the fatty body (column 3, lines 15-35). Papantoniou teaches vegetable based oils such as sweet almond oil, avocado oil, ricin oil, and olive oil for use in the fatty body (column 3, lines 30-50).

Papantoniou does not immediately embody fatty bodies consisting of vegetable based materials as set forth by instant claim 36.

Papantoniou does not immediately embody fatty bodies consisting of vegetable based materials which are free of synthetic chemicals and animal byproducts as set forth by instant claim 77.

Chemistry in Cosmetics teaches that there is a rising demand from consumers for natural, plant based products with no synthetic chemicals (page 1, paragraph 5).

Toxic Chemicals in Cosmetics teaches that some silicone emollients cause skin irritation and potentially act as tumor promoters (page 9, silicone derived emollients).

Green Cosmetics teaches that there is an active movement, especially in the cosmetics industry, to market green products (page 1, last paragraph). The green marketing has evolved into something approximating a religion (page 1, last paragraph). The green philosophy covers a range of ingredients and formulations (page 1, last paragraph). The green philosophy has been used in the cosmetics field for decades (page 2, paragraph 2). *Green Cosmetics* goes on to teach that in the green cosmetics field, having no animal byproducts in the formulations is boast worthy (page 4, paragraph 2).

With regard to instant claims 36 and 77, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have removed the synthetic and animal-derived reagents from Papantoniou's composition and substituted the plant based equivalents taught by Papantoniou to produce an oil phase consisting of vegetable based raw products in order to meet consumer demand for cosmetics with no synthetic chemicals. The artisan of ordinary skill would have been further motivated to remove the animal reagents and substitute natural plant based

reagents in Papantoniou's composition to meet the consumer demand for green cosmetics. The artisan of ordinary skill, at the time the invention was made, knew that cosmetic compositions which comprised no animal byproducts were boast worthy products for cosmetics companies.

Claim 72 has only changed with regard to the amendments made to the independent claim 36 from which claim 72 depends. The amendments to claim 36 have been discussed above.

Claims 36, 40-42, 44, 45, 51, 53-55, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,937,811 (Papantoniou, 1976) in view of each newly applied *Chemistry in Cosmetics*, ncwsnc.cheminst.ca/articles/2001_cosmetics_e.htm, newly applied *Toxic Chemicals in Cosmetics* accessed from www.hallgold.com/toxic-chemical-ingredients-directory.htm, and newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, www.jonentine.com/articles/drug_cosmetic_ind.htm, published 2/01/1995 and in further view of US Patent No. 5,690,915 (Eteve, 1997). The newly applied references were applied in response to applicant's amendment of the claims submitted 05/04/2009.

Example III (Col 10, lines 30-55) of Papantoniou teaches a lip polish (i.e. make up; instant claim 36). This lip polish comprises a lipid component (Fatty composition C). Fatty composition C comprises the vegetable oil phases of candellila wax, carnauba wax, and ricin oil (Col 10, lines 30-55; instant claims 36 and 40); these reagents

comprise 1.9%, 1.9%, and 37% by weight, of the composition respectively. Thus the content of the vegetable oils is 37% (Col 10, lines 30-55; instant claims 41, 44) and the content of the vegetable waxes is 3.8% (Col. 10, lines 30-55; instant claims 42 and 45). The composition comprises a solid phase which comprises the aluminum lake of the organic pigment FD&C Yellow No.5. and a zirconium lake of the organic pigment D and C red No 21 (column 10, lines 30-45; instant claims 51, 54, and 55). The solid phase comprises 2% of the composition by weight. Papantoniou teaches use of inorganic pigments, such as titanium oxide, such as in the lip rouge of Example II (Col. 9, lines 50-end; instant claims 51 and 60). Papantoniou teaches that inorganic pigments such as oxides of metals like iron and chromium may be employed in amounts of about 1 to 6% of the composition (Col. 5 lines 60-end; Col.6, lines 1-5; instant claims 53, 59 and 60). Use of anti-solar agents is also taught by Papantoniou (Col.5, lines 55-60). Papantoniou teaches vegetable based waxes such as carnauba wax and coco butter for use in the fatty body (column 3, lines 15-35). Papantoniou teaches vegetable based oils such as sweet almond oil, avocado oil, ricin oil, and olive oil for use in the fatty body (column 3, lines 30-50).

Papantoniou does not immediately embody fatty bodies consisting of vegetable based materials which are free of synthetic chemicals and animal byproducts as set forth by instant claim 36.

Chemistry in Cosmetics teaches that there is a rising demand from consumers for natural, plant based products with no synthetic chemicals (page 1, paragraph 5).

Toxic Chemicals in Cosmetics teaches that some silicone emollients cause skin irritation and potentially act as tumor promoters (page 9, silicone derived emollients).

Green Cosmetics teaches that there is an active movement, especially in the cosmetics industry, to market green products (page 1, last paragraph). The green marketing has evolved into something approximating a religion (page 1, last paragraph). The green philosophy covers a range of ingredients and formulations (page 1, last paragraph). The green philosophy has been used in the cosmetics field for decades (page 2, paragraph 2). *Green Cosmetics* goes on to teach that in the green cosmetics field, having no animal byproducts in the formulations is boast worthy (page 4, paragraph 2).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have removed the synthetic and animal-derived reagents from Papantoniou's composition and substituted the plant based equivalents taught by Papantoniou to produce an oil phase consisting of vegetable based raw products in order to meet consumer demand for cosmetics with no synthetic chemicals. The artisan of ordinary skill would have been further motivated to remove the animal reagents and substitute natural plant based reagents in Papantoniou's composition to meet the consumer demand for green cosmetics. The artisan of ordinary skill, at the time the invention was made, knew that that cosmetic compositions which comprised no animal byproducts were boast worthy products for cosmetics companies.

Claim 58 has only changed with regard to the amendments made to the independent claim 36 from which claim 58 depends. The amendments to claim 36 have been discussed above.

Claims 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papantoniou, newly applied *Chemistry in Cosmetics*, newly applied *Toxic Chemicals in Cosmetics*, newly applied *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, and Eteve as applied to claims 36, 40-42, 44, 45, 51, 53-55, and 58-60 above, and further in view of US Patent No. 5,605,679 (Hansenne, 1997).

Applicant's amendment to instant claim 36 required the newly applied references to provide a motivation to remove the non-vegetable based reagents from the oil phase and/or substitute vegetable-based equivalents to the oil phase. The teachings of the newly applied references are discussed above in the obviousness rejection of the independent claim. Claims 61-62 have only changed with regard to the amendments made to the independent claim 36 from which they depend. The amendments to claim 36 have been discussed above.

Response to Arguments

As discussed above in the instant rejections, there has been a "green movement" within the cosmetics field for at least several decades. As presented by several of the above references, consumers have been moving toward plant based products (i.e.

products free from animal byproduct and synthetic chemicals) since at least the mid-90's. While the instant invention is focused on using cosmetic reagents that are renewable (i.e. originating from plant based materials), the use of vegetable based reagents is shared with the green cosmetics field. Furthermore, artisans of ordinary skill in the art knew of vegetable based functional equivalents for animal-based and synthetic reagents at the time of filing. A particular challenge for applicant to overcome may be demonstrating that particular vegetable based reagents are not functionally equivalent to their animal-based or synthetic counterparts. For example, the artisan of ordinary skill recognized that hydrogenated vegetable oil and C₂₄₋₄₅ alkyl methicone were functionally equivalent solid formers as taught by Rabe. While Lebok teaches away from natural waxes, Lebok does not teach away from hydrogenated vegetable oils. Would hydrogenated vegetable oil be a suitable substitute for C₂₄₋₄₅ alkyl methicone in Lebok's composition?

Applicant also discloses in the instant specification that it is the mixture of hydrogenated jojoba and meadowfoam seed oil that reduces the rancidity of the composition while permitting the composition to be easy to apply.

A cursory search of the art has demonstrated that meadowfoam seed oil, "sulfurized" wax esters of jojoba (i.e. a synthetic wax ester) have been taught for use together as early as 1991 (see US Patent No. 5,023,312) in the lubricant/machinery/aviation/engine arts. In the cosmetics art, jojoba wax (i.e. hydrogenated jojoba) and meadowfoam seed oil were known for use in topical personal

care compositions (see US Patent No. 6,001,341, 1999) and to be functionally equivalent lipid sequestering agents (see US Patent No. 6,551,607, 2003).

Applicant may wish to consider whether it is the combination of hydrogenated jojoba and meadowfoam seed oil which contribute over the prior art. If appropriate, applicant may wish to consider amending their instant claims to require hydrogenated jojoba and meadowfoam seed oil. However, based upon Applicant's traverse, applicant should be aware that hydrogenated vegetable oils are synthetic (Reply, page 10, paragraph 2), which may be important should Applicant elect to amend instant claim 36.

Applicant alleges that instant claim 36 has been amended to eliminate oils from other sources such as animal, mineral, or synthetic sources (Reply, page 10, paragraph 2).

Applicant's traverse has been considered but is not found persuasive because hydrogenated vegetable oils are synthetic oils as evidenced by US Patent No. 5,891,471 (Miller, 1999; column 5, lines 20-30).

Applicant alleges that the '811 (i.e. Papantoniou), Koulbanis, Bonda, and Morane contain components derived from animal sources (Reply, page 11, paragraph 1).

Applicant's traverse has been carefully considered but is not persuasive. Papantoniou, Koulbanis, and Bonda, as discussed above, each teach vegetable based equivalents to the animal derived oils and waxes. The teachings of *Chemistry in Cosmetics*, *Toxic Chemicals in Cosmetics*, *Green Cosmetics: The Definition Undergoes*

Broadening but Consumer Interest Remains High provide motivation for substitution of these animal derived reagents with their vegetable based alternatives.

Morane also teaches use of animal derived reagents in the makeup composition. The teachings of the *Chemistry in Cosmetics*, *Toxic Chemicals in Cosmetics*, *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High* provide motivation for removal of these animal derived reagents from the makeup composition.

Applicant alleges that Koulbanis, Lebok, and Calello teach use of synthetic substances in the oil phase (Reply, page 11, paragraph 1).

Applicant's traverse has been considered but is not persuasive.

As discussed above, Koulbanis and Calello each teach vegetable based equivalents to the synthetic oils and waxes. The teachings of *Chemistry in Cosmetics*, *Toxic Chemicals in Cosmetics*, *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High* provide motivation for substitution of these animal derived reagents with their vegetable based alternatives.

Lebok teaches C₃₀₋₄₅ alkylmethicone (i.e. a synthetic chemical) for use in his composition. While Lebok does not teach a vegetable-based alternative, Rabe teaches that C₂₄₋₄₅ alkyl methicone and hydrogenated vegetable oils are functionally equivalent solid formers. Therefore, based upon the motivation provided by the teachings of *Chemistry in Cosmetics*, *Toxic Chemicals in Cosmetics*, and *Green Cosmetics: The Definition Undergoes Broadening but Consumer Interest Remains High*, it would have

been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have substituted the vegetable-based hydrogenated vegetable for the synthetic C₃₀₋₄₅ alkylmethicone taught by Lebok.

Conclusion

No claims are allowed. No claims are free of the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1619

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORI MATTISON/
Examiner, Art Unit 1619

/Anne Marie Grunberg/

Supervisory Patent Examiner, Art Unit 1661